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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ) Examiner: Helms, Larry Ronald  
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 Vanessa HSEI, et al. ) Art Unit: 1642  
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 Application Serial No. 09/726,258 ) Attorney's Docket No. 39766-0093 C1  
 )  
 Filed: November 29, 2000 ) Customer No. 25213  
 )  
 For: **ANTIBODY FRAGMENT-PEG** )  
 **CONJUGATES** )  
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**EXPRESS MAIL LABEL NO. EV 582 628 116 US**  
**DATE MAILED: FEBRUARY 3, 2005**

### REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)

#### MAIL STOP ISSUE FEE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

In the Issue Notification, the *Determination of Patent Term Adjustment under 35 U.S.C. 154(b)* states that the PTA is “47” days. Applicants believe that the correct PTA to be accorded to the above-referenced patent is 0 days. Applicants hereby notify the United States Patent and Trademark Office that the PTA cited on the Issue Notification is believed to be in error, and request that the PTA accorded to the above-referenced patent be 0 days.

## REMARKS

### Patent Term Adjustment

The total Patent Term Adjustment was noted as 47 days on the "Determination of Patent Term Adjustment under 35 U.S.C. 154(b)" form that accompanied the Notice of Allowance for United States Patent Application Serial No. 09/726,258.

In reviewing the Patent Term Adjustment History as published in the PAIR/PALM system of the U.S. Patent and Trademark Office (USPTO), Applicants note that Applicants filed a Notice of Appeal, a Terminal Disclaimer, and an Amendment on 7/23/03, pursuant to a final rejection mailed by the USPTO on 3/25/03. After the Notice of Appeal was filed, the six-month period following mailing of the final rejection ended on 9/24/03; an Advisory Action was mailed by the USPTO on 9/29/03; a Request for Extension of Time was filed by Applicants on 12/22/03; an RCE was filed by Applicants on 12/22/03; and a Non-Final Rejection was mailed by the USPTO on March 17, 2004.

115 days are counted against the USPTO for the period between 7/23/03 and 3/17/04; the 115 days are apparently calculated as the number of days following 11/23/03 (the date four months after Applicants' filing of the amendment of 7/23/03) until 3/17/04 when the USPTO mailed the Non-Final Rejection.

Applicants believe that the total of 115 days counted against the USPTO is in error. The Patent Term Adjustment History as indicated via the Private PAIR system shows that the 115-day time period counted against the USPTO begins when Applicants filed a Notice of Appeal on July 23, 2003. The period of adjustment due to USPTO delay discussed in 37 C.F.R. § 1.702(e) is determined under 37 C.F.R. § 1.703(e) with regard to a Notice of Appeal that resulted in a final decision in favor of the applicants by the Board of Appeals and Interferences or a Federal court. However, Applicants note that the Notice of Appeal filed on July 23, 2003 did not result in such a final decision, since Applicants filed a Request for Continued Examination (RCE) on December 22, 2003. Thus, since the Notice of Appeal filed on July 23, 2003 did not result in a decision in favor of Applicants, it is believed that the period of adjustment due to USPTO delay (under 37 C.F.R. § 1.702(e) as determined under 37 C.F.R. §

1.703(e)) is not applicable, and so should not be counted against the USPTO. Thus, the 115 days counted against the USPTO is believed to be in error.

Even if time after the filing of the Notice of Appeal is to be counted against the USPTO, it is believed that the amount of 115 days in error. Since an RCE was filed on December 22, 2003 (a request for Extension of Time was also granted to Applicants on December 22, 2003), it is believed that days after December 22, 2003 should not be counted against the USPTO. Calculating the days from November 23, 2003 (the day that is four months after the filing of the Notice of Appeal) to December 22, 2003, the number of days to be counted against the USPTO is 29, not 115.

Thus, including the 50-day delay from the period ending March 20, 2002, the total PTO Delay should have been 79 days (not 165 days). This number is less than the total Applicant Delay of 118 days, so that the total PTA should be 0 days.

### **Terminal Disclaimer**

The above remarks notwithstanding, under 37 CFR §1.703(g), the term of a patent shall not extend beyond the expiration date specified in the disclaimer. The time period to be added to the effective patent term under either of the theories discussed above has already been disclaimed through a Terminal Disclaimer.

This application is subject to a Terminal Disclaimer over U.S. Patent 6,117,980 (filed February 21, 1997, and so having a full term extending until February 21, 2017) and over U.S. Patent 6,133,426 (filed February 20, 1998, and itself subject to a Terminal Disclaimer over U.S. Patent 6,117,980 and over U.S. Patent 6,025,158, believed to expire on or before February 20, 2018). Thus, under effect of 37 CFR §1.703(g), the total PTA should be 0 days.

Applicants wish to ensure that the Patent Term Adjustment calculation is correct even if it does not affect the actual term of a patent issued on the present application that is enforceable by Applicants. Thus, Applicants request that the USPTO recalculate the Patent Term Adjustment in view of the above remarks.

## CONCLUSION

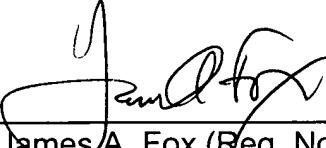
Applicants request that Patent Term Adjustment for U.S. Patent Application Serial No. 09/726,258 be corrected to be 0 days instead of the 47 days indicated in the Issue Notification.

Applicants hereby authorize payment from Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39766-0093 C1) for the PTA adjustment request as set forth in 37 C.F.R. § 1.18(e). However, Applicants do not believe the \$200.00 charge for reconsideration of the PTA should be charged to the Applicants, as Applicants believe that an error was made on the part of the PTO. Please deposit any refund, or, if applicable, charge any additional fees that may be due in connection with this application, to the afore-mentioned Deposit Account. Should there be any questions, please contact the undersigned at the correspondence address listed below.

Respectfully submitted,

Date: February 3, 2005

By:

  
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James A. Fox (Reg. No. 38,455)

HELLER EHRLMAN WHITE & McAULIFFE LLP  
275 Middlefield Road  
Menlo Park, California 94025  
Telephone: (650) 324-7000  
Facsimile: (650) 324-0638

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